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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR          | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------------|---------------------|------------------|
| 09/545,088      | 04/07/2000  | Charles Gilbert Heisinger JR. |                     | 1969             |

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[REDACTED] EXAMINER

FLEURANTIN, JEAN B

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2172

DATE MAILED: 06/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                            |
|------------------------------|-------------------------------|----------------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)               |
|                              | 09/545,088                    | HEISINGER, CHARLES GILBERT |
|                              | Examiner<br>Jean B Fleurantin | Art Unit<br>2172           |

(10)

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 March 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 36-40,44 and 47-64 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 36-40,44 and 47-64 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 36-40, 44 and 47-64 are remained pending for examination.
2. Applicant's arguments submitted on 03/14/2003 with respect to claims 36-40, 44 and 47-64 have been fully considered but they are not persuasive.

### ***Response to Applicant' Remarks***

In response to applicant's argument on page 4, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using both databases to create an electronic message to send to merchant for purchasing goods and services) are not recited in the rejected claim(s) 36, 47 and 56. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, in columns 3 and 6, lines 18-25 and 9-26, a service for searching a database of contact number and connecting a calling telephone to the desired contact number is provided in which a telephone number associated with the service called; and database comprised of five different relational database tables, these include a user database table, personal contact list table of each user, update contact list tables, rejected updated contact list tables and a listing arbitration table.

In response to applicant's argument on page 4, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marwell includes a service for searching a database of contact number and connecting a calling telephone to the desired contact number is provided in which a telephone number associated with the service called; and database comprised of five different relational database tables, these include a user database table, personal contact list table of each user, update contact list tables, rejected updated contact list tables and a listing arbitration table, (see cols. 3 and 6, lines 18-25 and 9-26). Foladare includes based on the profile information the centralized electronic mail device further determines the receiving party's electronic mail message is to be sent, the centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices, (see col. 1, lines 43-46). Thus the arguments are not persuasive.

***Claim Rejections - 35 U.S.C. § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

<sup>64</sup>  
Claims 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marwell et al. (U.S. Pat. No. 6,404,884) in view of Foladare et al. (U.S. Pat. No. 6,311,210) ("Marwell") ("Foladare").

As per claim 36, Marwell teaches a method of addressing an electronic message (see col. 1, lines 12-19) as claimed comprises the step of providing a first database containing stored telephone numbers and user addresses to each of the stored telephone numbers (thus, a database is coupled to the web server such that the first database stores the list of personal contact data, the list of personal contact data stored in the fist database is updated with the personal contact update data received by the web server; which is readable as providing a first database containing stored telephone numbers and user addresses to each of the stored telephone numbers)(see cols. 1-2, lines 66-3);

providing a second database containing identification codes and product information corresponding to each identification codes (thus, the personal contact list tables preferably store contact names and numbers for each corresponding user, the personal contact list can also be arranged to include more detailed information about each contact, each entry in a contact list is assigned a unique identification number; which is readable as providing a second database containing identification codes and product information corresponding to each identification codes)(see col. 6, lines 19-26);

receiving a telephone call from a user including one of the identification codes (thus, using a telephone to contact a service for searching a database for desired information and performing an operation requested by a user is provided in which, a telephone number associated with the service is called; which is equivalent to receiving a telephone call from a user including one of the identification codes)(see col. 3, lines 40-43);

identifying the received telephone number from the telephone call (thus, the call is connected to the desired contact number; which is readable as receiving a telephone call from a user including one of the identification codes) (see col. 3, lines 29-30);

retrieving the user address from the first database by comparing the receiving telephone number with the stored telephone numbers (thus, a method for using a telephone to contact a

service for searching a database for desired information and performing an operation requested by a user is provided in which, a telephone number associated with the service is called; which is equivalent to retrieving the user address from the first database by comparing the receiving telephone number with the stored telephone numbers)(see col. 3, lines 40-43);

retrieving the addressing information corresponding to the received identification code (thus, the database is searched for a contact list corresponding to an identification number of the calling telephone, which is readable as retrieving the addressing information corresponding to the received identification code)(see col. 3, lines 45-46);

addressing the electronic message according to the retrieved address (thus, the user can send an electronic mail from user terminal 10 to web server 68 describing their desired changes in detail; which is readable as addressing the electronic message according to the retrieved address)(see col. 12, lines 37-39). But, Marwell does not explicitly indicate sending at least a portion of the retrieved user information via electronic message. However, Foladare indicates the centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices, (see col. 1, lines 47-50). Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify teachings of Marwell and Foladare with sending at least a portion of the retrieved user information via the electronic message. This modification would allow the teachings of Marwell and Foladare to improve the accuracy and the reliability of the method and system for telephonically selecting, addressing, and distributing messages, and provide assist sending electronic mail (see col. 1, lines 27-28).

As per claims 37 and 48, Marwell teaches a method as claimed, wherein the electronic message is a fax (see col. 18, lines 65-66).

As per claims 38 and 49, Marwell teaches a method as claimed, wherein the electronic message is an email (see col. 18, lines 65-66).

As per claims 39 and 50, Marwell teaches a method as claimed, wherein the electronic message is a voice mail (thus, voice activated dialing, which is equivalent to electronic message is a voice mail)(see col. 2, lines 1-2).

As per claims 40 and 51, the limitations of claims 40 and 51 are rejected in the analysis of claim 57, and these claims are rejected on that basis.

As per claims 41 and 52, the limitations of claims 40 and 51 are rejected in the analysis of claim 36, and these claims are rejected on that basis.

As per claims 42 and 53, Marwell teaches a method as claimed, further comprise the step of retrieving a second electronic message to the user (thus, voice activated dialing systems use speech recognition patterning to search through a stored contact database to initiate dialing; which is readable as retrieving a second electronic message to the user)(see col. 2, lines 4-6).

As per claims 43 and 54, Marwell teaches a method as claimed, further comprise the step of sending a second electronic message to the user (thus, send electronic mails; which is readable as sending a second electronic message to the user)(see col. 18, line 63).

As per claim 44, the limitations of claim 44 are rejected in the analysis of claim 57, and this claim is rejected on that basis.

As per claims 45 and 55, the limitations of claims 45 and 55 are rejected in the analysis of claim 57, and these claims are rejected on that basis.

As per claim 46, the limitations of claim 46 are rejected in the analysis of claim 57, and this claim is rejected on that basis.

As per claims 47 and 56, in addition to the discussion in claim 36, Marwell further teaches an ANI for identifying the received telephone number from the telephone call (thus, telephone number, is recognized by cellular MSC 7 and transmitted to tandem switch 22 ACD 24 and CSR terminal 18 as an automatic number identification (ANI) data string; which is readable

as an ANI for identifying the received telephone number from the telephone call)(see col. 10, lines 28-31).

As per claim 57, in addition to the discussion in claim 36, Marwell further teaches purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database (thus the user can store his or her clothing sizes in database 16 and use system 2 to contact a customer service representative to arrange for purchase of a pair of pants, the customer service representative has access to a number of vendors whose relevant data is stored in database 16, for example, telephone number, store location, price, Internet web page uniform resource location) (see col. 18, lines 10-16).

As per claims 58, 59 and 64, Marwell teaches a method as claimed, wherein user information includes address information (thus, contact addresses, which is readable as address information)(see col. 18, lines 20-23).

As per claims 60-62, Marwell teaches a method as claimed, wherein address information includes billing information (see col. 6, lines 16-17).

As per claim 63, Marwell teaches a method as claimed, further comprises the step of shipping the product (see col. 18, lines 22-23).

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

5. Any inquiry concerning this communication from examiner should be directed to Jean Bolte Fleurantin at (703) 308-6718. The examiner can normally be reached on Monday through Friday from 7:30 A.M. to 6:00 P.M.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Mrs. KIM VU can be reached at (703) 305-8449. The FAX phone numbers for the Group 2100 Customer Service Center are: *After Final* (703) 746-7238, *Official* (703) 746-7239, and *Non-Official* (703) 746-7240. NOTE: Documents transmitted by facsimile will be entered as official documents on the file wrapper unless clearly marked "**DRAFT**".

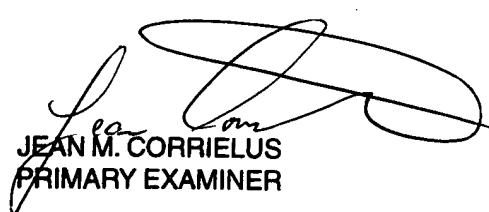
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2100 Customer Service Center receptionist whose telephone numbers are (703) 306-5631, (703) 306-5632, (703) 306-5633.



Jean Bolte Fleurantin

5/20/03

JBF/



JEAN M. CORRIELUS  
PRIMARY EXAMINER